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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/834,812	04/13/2001	Shuichi Kikuchi	450100-03161	8677

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EXAMINER

MILLER, BRIAN E

ART UNIT PAPER NUMBER

2652

DATE MAILED: 10/28/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/834,812

Applicant(s)

KIKUCHI, SHUICHI

Examiner

Brian E. Miller

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 08 August 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 2,4-10 and 16-19 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 8-10 is/are allowed.
- 6) ☒ Claim(s) 2,4-7 and 16-19 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

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Claims 2, 4-10, 16-19 are now pending.

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 2, 16, 18 are rejected under 35 U.S.C. 112, second paragraph, as failing to set forth the subject matter which applicant(s) regard as their invention. Evidence that claims 2, 16, 18 fail(s) to correspond in scope with that which applicant(s) regard as the invention can be found throughout the disclosure and the Abstract filed originally. Applicant has set forth that the invention is directed to the screen portions of the shutter with roughened surfaces, and this statement indicates that the invention is different from what is defined in the claim(s) because these claims only set forth an aluminum elongated shutter configuration.

4. Claims 2, 4-7, 16-19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. (a) Claim 18, line 4, the phrase "formed on lock side" is indefinite. It is not readily apparent what applicant intends to claim with this language; (b) claim 16 recites language and limitations which are not directed to a shutter, e.g., elongate opening, one opening being more elongate than the opening on the other side, etc., therefore, since the preamble sets forth "A metal shutter", the metes and bounds of the claim is not readily

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ascertained by the Examiner, since the aforementioned opening(s) are not encompassed by a shutter.

***Claim Rejections - 35 USC § 102***

5. Claims 2, 16, 18 are rejected under 35 U.S.C. 102(b) as being anticipated by Kikuchi et al (JP 10-162541). In so far as the claims are definite and understood, Kikuchi et al discloses a disc cartridge with an aluminum metal shutter, such that the aluminum substrate 11 has a thickness between 0.15-0.5mm (see paragraph [0046])(re claim 2) and the cartridge includes elongated openings, one longer than the other; the shutter comprising a longer rectangular portion and a shorter rectangular portion with a interconnecting edge portion (see FIG. 19).

***Claim Rejections - 35 USC § 103***

6. Claims 2, 4-7, 16-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Takeda et al (US 5,308,708) in view of Kikuchi et al (JP 10-162541). In so far as the claims are definite and understood, Takeda et al discloses a stainless steel metal shutter (FIG. 5) for a disc cartridge which includes a plastic enclosure and disc medium (col. 1, lines 13-22), further including: a screen portion having inside and outside surfaces B, C (FIG. 5) having an indication area on the outside surface B, the indication area including a rough surface portion, i.e., having a surface roughness, and an inside surface thereof C, having another rough surface area (see col. 4, lines 17-25 and 44-58); wherein the shutter has a thickness between 0.15 mm and .5 mm, i.e., 0.2 mm (see col. 8, line 54) (re claim 2); wherein the roughness of the inside surface is less than the

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roughness of the outside surface (see Table 2); wherein the indication area B is provided on a flat portion of the screen portion.

Takeda et al is silent as to the shutter being elongated and to the material being aluminum.

Kikuchi et al discloses a disc cartridge with an aluminum metal shutter, such that the aluminum substrate 11 has a thickness between 0.15-0.5mm (re claim 2) and the cartridge includes elongated openings, one longer than the other; the shutter comprising a longer rectangular portion and a shorter rectangular portion with a interconnecting edge portion (see FIG. 19).

From these teachings, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have utilized aluminum in place of stainless steel and to have modified the shape of the shutter to have one longer rectangular portion. Lacking any unobvious or unexpected results, the motivation would have been: aluminum would have been a recognized substitution for stainless steel and the shape of the shutter being elongated would have resulted through routine engineering optimization and experimentation, and as taught by Kikuchi (JP '541).

7. Claims 5-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Takeda et al in view of Kikuchi (JP '541), as set forth according to claims 16-17, above, and further in view of Kikuchi (US 5,729,272). Although Takeda et al suggests "printing" can be configured on the shutter (see col. 2, lines 15-20) is silent as to any details thereof. Kikuchi, however, discloses specific details on how to provide characters, pictures, etc. on a metal shutter surface (see col. 1, lines 42-55). As shown in FIGs. 1-5, shutter 5 is provided with a heat transfer film 10 which is inherently smoother than the roughness of the shutter. From this teaching, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have

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provided a heat transfer film onto the plain shutter of Takeda et al. The motivation would have been: providing such a film on a shutter would have colorfully displayed contents, pictures, printing, etc. on the shutter, while increasing accuracy and reducing process steps, which advantages would have been readily realized by a skilled artisan.

***Allowable Subject Matter***

8. Claims 8-10 are allowable over the prior art. Reasons for allowance will be set forth upon allowance of the application.

***Response to Amendment***

9. Applicant's arguments with respect to new claims 16 & 19 have been considered but are moot in view of the new ground(s) of rejection.

A...Applicant asserts that Takeda et al, and for that matter, all the prior art of record, does not teach or reasonably suggest an aluminum shutter with different sized rectangular elongated portions as now set forth in the claims.

In response, although these newly introduced claims (16 & 18) do not set forth applicant's invention (see 112 paragraph 2 rejections, supra) nor were these limitations previously set forth, the Examiner has relied upon newly cited reference to Kikuchi et al (JP 10-162541) which anticipates the aforementioned newly recited limitations.

B...As no other specific arguments regarding other limitations in any of the other rejected claims have been set forth, it is considered that the previously art applied is appropriate for the remaining claims and is maintained.

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***Conclusion***

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian E. Miller whose telephone number is (703) 308-2850. The examiner can normally be reached on M-F 7:45am-5:15pm (FF off).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hoa T. Nguyen can be reached on (703) 305-9687. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9314 for regular communications and (703) 872-9314 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-4750.

A handwritten signature in black ink, appearing to read "B. Miller", is written over the printed name.

**Brian E. Miller**  
**Primary Examiner**  
**Art Unit 2652**

bem  
October 17, 2003